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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,247	12/31/2003	Masahiro Yamanaka	SIC-02-009-3	3824
29863	7590	09/14/2005	EXAMINER	
DELAND LAW OFFICE P.O. BOX 69 KLAMATH RIVER, CA 96050-0069			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,247

Applicant(s)

YAMANAKA, MASAHIRO

Examiner

Vinh T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-30 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-30 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The Amendment filed on June 28, 2005 has been entered.
2. The drawings were received on December 31, 2003. These drawings are accepted by the Examiner.
3. The information disclosure statement filed June 28, 2005 has been considered.
4. Claim 36 is objected to because of the following informalities: no antecedent basis is seen for the term "the gripping rim". Appropriate correction is required.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 22-24, 26-28, and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Fultz (US Patent No. 5,445,483).

Regarding claim 22, Fultz teaches a tool 20 for an axle bolt comprising: a tool body 30; a plurality of splines 35 evenly circumferentially disposed on and extending radially outwardly from the tool body 11, and a tool operating member 33 (Fig. 2) projecting radially outwardly from the tool body 30, wherein the tool operating member 33 is axially thinner than the tool body 30.

Regarding claim 23, the tool operating member 33 has a disk shape.

Regarding claim 24, the tool body 30 extends from a side surface of the tool operating member 33.

Regarding claim 26, the tool operating member 33 includes a gripping rim (at 33 in Fig. 4) extending from a side surface thereof.

Regarding claim 27, the gripping rim 33 is disposed at a radially outermost portion of the tool operating member 33.

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Regarding claim 28, the tool body 30 extends from a first side surface of the tool operating member 33, and wherein the gripping rim 33 extends from an opposite second side surface of the tool operating member 33.

Regarding claim 35, Fultz teaches a tool 20 for an axle bolt comprising: a tool body 30; a plurality of splines 35 circumferentially disposed on and extending radially outwardly from the tool body 30; a tool operating member 33 projecting radially outwardly from the tool body 30; and a gripping rim (at 33 in Fig. 4) extending from a side surface of the tool operating member 33, wherein the gripping rim forms an axially outermost surface of the entire tool.

Regarding claim 36, Fultz teaches a tool 20 for an axle bolt comprising a tool body 30; a plurality of splines 35 circumferentially disposed on and extending radially outwardly from the tool body 30; a tool operating member 33 projecting radially outwardly from the tool body 30; wherein the tool body 30 extends from a first side surface of the tool operating member 33; and wherein a gripping rim (at 33 in Fig. 4) projects from an opposite second side surface of the tool operating member 33.

Regarding claim 37, Fultz teaches a tool 20 for a bicycle crank axle bolt that screws to a crank axle that rotates as the bicycle is pedaled so that the crank axle bolt attaches a crank arm to the crank axle, the tool comprising a tool body 30; a plurality of splines 35 circumferentially disposed on and extending radially outwardly from the tool body 30 and dimensioned so as to fit within the bicycle crank axle bolt; and a tool operating member 33 extending radially outwardly from the tool body 30.

Claim 37 is anticipated by Fultz because Fultz teaches each and every positively claimed element. Referring the tool the merely inferentially included elements or intended use elements

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such as the crank axle bolt is not accorded patentable weight. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, Fultz's tool 22 is a nut, thus, it is capable of being used with the bolt such as the bolt 23 in Fig. 1.

7. Claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by Nagano'149 (EPO 0512149 A1 cited by Applicant).

Nagano teaches a tool 9 (Fig. 3) for a bicycle crank axle bolt 3 that screws to a crank axle that rotates as the bicycle is pedaled so that the crank axle bolt attaches a crank arm to the crank axle, the tool comprising a tool body 12; a plurality of splines 12a circumferentially disposed on and extending radially outwardly from the tool body 12 and dimensioned so as to fit within the bicycle crank axle bolt 3; and a tool operating member 9a extending radially outwardly from the tool body 12.

Claim 37 is anticipated by Nagano because Nagano teaches each and every positively claimed element. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, Nagano's tool is capable of being used with the bicycle crank axle bolt 3.

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8. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Kanaan et al. (US Patent No. 5,947,671).

Kanaan teaches a tool 10 (Fig. 4) for an axle bolt comprising: a tool body 18; a plurality of splines 70 circumferentially disposed on and extending radially outwardly from the tool body 18, a tool operating member 68 *projecting* radially outwardly from the tool body 18, wherein the tool operating member 68 includes a knurled outer peripheral surface 26.

9. Claims 22-29 are rejected under 35 U.S.C. 102(b) as being unpatentable over Trembley (US Patent No. 3,742,808).

Regarding claim 22, Trembley teaches a tool 10 for an axle bolt comprising: a tool body 12; a plurality of splines 34 *evenly* circumferentially disposed on and extending radially outwardly from the tool body 12, and a tool operating member 14 (Fig. 1) projecting radially outwardly from the tool body 12, wherein the tool operating member 14 is axially thinner than the tool body 12.

Regarding claim 23, the tool operating member 14 has a disk shape.

Regarding claim 24, the tool body 12 extends from a side surface of the tool operating member 14.

Regarding claim 25, Trembley teaches a tool 10 (Fig. 4) for an axle bolt comprising: a tool body 12; a plurality of splines 34 circumferentially disposed on and extending radially outwardly from the tool body 12, a tool operating member 14 *projecting* radially outwardly from the tool body 12, wherein the tool operating member 14 includes a knurled outer peripheral surface 14.

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Regarding claim 26, the tool operating member 14 includes a gripping rim (at 14 in Fig. 1) extending from a side surface thereof.

Regarding claim 27, the gripping rim 14 is disposed at a radially outermost portion of the tool operating member 14.

Regarding claim 28, the tool body 12 extends from a first side surface of the tool operating member 14, and wherein the gripping rim 14 extends from an opposite second side surface of the tool operating member 14.

Regarding claim 29, the gripping rim 14 has a knurled outer peripheral surface

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trembley.

Trembley teaches the invention substantially as claimed. However, Trembley teaches twelve splines instead of eight splines (*id.*, col. 4, line 66 *et seq.*).

It is common knowledge in the art to change Trembley's number of splines from twelve to eight in order to couple Trembley's tool with the axle bolt or the like 76. The use of eight splines is notoriously well known (see, e.g., eight splines in the tool 7 of US Patent No. 5,852,954 issued to Yamanka). See *Sjolund v. Musland*, 6 USPQ2d 2020, 2026 (CAFC)(to change a plurality of panels to a single panel is obvious).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to change Trembley's number of splines from twelve to eight in order to couple Trembley's tool with the axle bolt or the like as taught or suggested by common knowledge in the art.

11. Claims 22 and 35-37 are rejected under 35 U.S.C. 102(b) as being *clearly* anticipated by Berecz (US Patent No. 4,367,060).

See, e.g., Fig. 5 and *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto, supra*.

12. Applicant's arguments filed June 28, 2005 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 22-30 and 35-37 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

September 7, 2005

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal flourish extending to the right.

Vinh T. Luong
Primary Examiner